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HP Inc. and HP Deutschland GmbH

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

*In re Ex Parte Application for an Order
Pursuant to 28 U.S.C. § 1782 Authorizing
Discovery for Use in Foreign Proceedings of*

HP Inc. and HP Deutschland GmbH,

Applicants.

Case No. 5:24-mc-80120

**DECLARATION OF STEPHAN DORN
IN SUPPORT OF EX PARTE
APPLICATION OF HP INC. AND HP
DEUTSCHLAND GMBH FOR AN
ORDER PURSUANT TO 28 U.S.C. §
1782 TO OBTAIN DISCOVERY FOR
USE IN FOREIGN PROCEEDINGS**

Pursuant to 28 U.S.C. § 1746, I, Stephan Dorn, declare as follows:

1. I am an attorney admitted to practice in Germany and an associated lawyer and Counsel in the Dusseldorf office of the law firm Freshfields Bruckhaus Deringer PartG mbB, which represents HP Inc. and HP Deutschland GmbH in two lawsuits in Germany (each a “German Proceeding” and, together, the “German Proceedings”) brought by Nokia Technologies Oy (“Nokia”).

1 2. I studied law at the Rheinische-Friedrich-Wilhelms-University Bonn and completed
2 my Referendariat (legal clerkship) in the circuit of the Cologne Higher Regional Court. I have been
3 admitted as an Rechtsanwalt (attorney at law) to practice before the German courts since 2013.

4 3. Before joining Freshfields, I worked at Hogan Lovells International LLP in the field
5 of patent litigation for six years.

6 4. In 2011, I completed Dr iur (PhD in law) studies at the Rheinische-Friedrich-
7 Wilhelms-University Bonn with a doctoral thesis published under the title “Technische
8 Standardisierung im Spannungsfeld von Immaterialgüterrecht, Kartellrecht und Innovation”
9 (Technical Standardization in the Field of Conflict between Intellectual Property Law, Antitrust
10 Law and Innovation), supervised by Prof Dr Matthias Leistner, LL.M. (Cambridge), holding the
11 Chair for Civil Law, Intellectual Property and Competition Law at the Rheinische-Friedrich-
12 Wilhelms-University Bonn.

13 5. I submit this Declaration in support of HP’s Ex Parte Application for an Order
14 Pursuant to 28 U.S.C. § 1782 to Obtain Discovery for Use in Foreign Proceedings. I make this
15 Declaration based on my own personal knowledge and documents that I have reviewed.

16 BACKGROUND OF THE PARTIES’ DISPUTE

17 6. In the German Proceedings Nokia asserts that HP has infringed Nokia’s Patents. In
18 particular, Nokia alleges that its patents are essential to the ITU-T Recommendation H.265: High
19 Efficiency Video Coding (“HEVC standard”), and that HP infringed its patents by implementing
20 this standard in HP’s products.

21 7. In the German Proceedings, Nokia is currently asserting that HP infringed two
22 patents (collectively, the “Nokia Patents”):

23 EP 2 774 375 (“EP 375”), titled “Method and apparatus for video coding”, filed by Nokia
24 on November 2, 2012.

25 EP 2 375 749 (“EP 749”), titled “System and method for efficient scalable stream
26 adaptation”, filed by Nokia on October 11, 2006.

27 8. The German Proceedings are pending in the Munich I Regional Court (the “German
28 Court”). Nokia initiated the German Proceedings in November of 2023. In one of the German

DECLARATION OF STEPHAN DORN IN SUPPORT OF HP’S APPLICATION PURSUANT TO 28 U.S.C. § 1782

1 Proceedings, Nokia has asserted the infringement of EP 375 (docket number 7 O 14901/23). In the
 2 other German Proceeding, Nokia has asserted the infringement of EP 749 (docket number 7 O
 3 14902/23).

4 9. HP has also commenced parallel nullity proceedings seeking to invalidate the Nokia
 5 Patents: For the German Proceedings, HP Deutschland GmbH filed nullity actions on May 14, 2024,
 6 before Germany's Federal Patent Court—the German court exclusively competent to hear nullity
 7 complaints for the Patents asserted in the German Proceedings.

8 10. HP has become aware, and Nokia has confirmed, that Nokia has concluded a set of
 9 agreements with third parties (the “Third-Party Agreements”) concerning patents owned by Nokia,
 10 potentially including the Nokia Patents. Existing rights relating to the Nokia Patents are relevant
 11 for the determination of the overall value and appropriateness of the portfolio license terms offered
 12 by Nokia to HP. Specifically, if the Nokia Patents are deemed “essential” to the HEVC standard,
 13 the German Court (or court sitting in appeal therefrom) will consider the Third-Party Agreements
 14 regarding the Nokia Patents as part of HP’s potential defense based on Nokia’s obligation to offer
 15 reasonable, and non-discriminatory (“RAND”) licensing terms.

16 11. Even though HP has asked Nokia for the Third-Party Agreements, Nokia has refused
 17 to provide them.

18 **HP’S REQUESTED SECTION 1782 DISCOVERY**

19 12. I have reviewed the document requests that HP seeks to serve on Nokia through its
 20 instant application pursuant to Section 1782, which are set forth in **Exhibit A**. Specifically, HP
 21 requests that Nokia produce any of Nokia’s license agreements related to the Nokia Patents or
 22 otherwise declared essential to the HEVC Standard, Nokia’s documents and communications related
 23 to the negotiation of those license agreements, and Nokia’s documents related to the royalties
 24 received under those license agreements. These requested documents are relevant to determining
 25 the appropriate royalty rate (RAND or otherwise) for any of Nokia’s patents that HP is found to
 26 infringe and for evaluating whether Nokia complied with its RAND obligations.

27 13. For the reasons described above, the discovery HP seeks will materially assist the
 28 German Court, including any court sitting in appeal therefrom, in adjudicating the dispute between

1 Nokia and HP. The discovery that HP seeks will impact the overall value of the portfolio license
 2 terms offered by Nokia to HP, which the German Court will also have to assess.

3 14. If the instant application pursuant to Section 1782 is granted, HP would be willing
 4 to enter a protective order limiting HP's use of the requested documents to the German Proceedings.
 5 A proposed protective order is attached to the application as **Exhibit B**.

6 AUTHORITY OF THE GERMAN COURT

7 15. Germany is a civil law country where the concept of discovery and/or document
 8 production does not exist under procedural law. Furthermore, under German law, a German court
 9 does not have authority to compel a party to provide documents.

10 16. Thus, the German Court cannot compel Nokia to produce the Third-Party
 11 Agreements, even though such documents are directly relevant and highly material to the issues
 12 raised by HP in the German Proceedings. The German Court can only request the submission of
 13 documents particularly specified or referenced by a party to the German Proceedings and does not
 14 have the authority to investigate or to order the investigation of facts or documents not already
 15 specified by the parties to the action. Furthermore, the German Court is not authorized to compel a
 16 party of the German Proceedings (Nokia) to submit documents at all.

17 17. Based on the rules explained above, even if the German Court decided that Nokia
 18 should produce the Third-Party Agreements to HP, the German Court could not compel Nokia to
 19 do so, and Nokia has thus far opposed providing these documents.

20 RECEPTIVITY OF THE GERMAN COURT TO EVIDENCE PROCURED THROUGH
 21 US DISCOVERY ASSISTANCE

22 18. While German courts cannot order the type of discovery available through Section
 23 1782, they will nevertheless be receptive to evidence obtained through Section 1782 proceedings in
 24 the United States. Under German law, any documents obtained pursuant to Section 1782 can be
 25 formally introduced into the German Proceedings, and the German Court, including the court
 26 overseeing any appeal of the German Proceeding concerning EP 749 and EP 375, would consider
 27 this evidence—without prejudice to decisions about the admission and consideration of any

1 particular document introduced according to general German rules regarding the admissibility of
 2 evidence.

3 19. Specifically, due to the constitutional right of access to the courts according to article
 4 103 para 1 of the German Basic Law, and the obligation to investigate the facts of the case to the
 5 extent possible (and necessary) according to Section 286 para. 1 of the German Code of Civil
 6 Procedure, German courts must generally consider all evidence submitted into legal proceedings.
 7 See Federal Supreme Court, decision of 19 June 2002, NJOZ, 2002, 2019 el sew. While there is no
 8 Federal Supreme Court decision addressing the issue of Section 1782 discovery specifically, the
 9 Federal Supreme Court of Germany has confirmed that the enforcement of a US judgement in
 10 Germany is not precluded when the judgment was based on evidence obtained in pre-trial discovery
 11 proceedings in the United States. See Federal Supreme Court, decision of 4 June 1992, NJW 1992,
 12 3096, 3099 (holding that the reliance on evidence obtained through US discovery does not violate
 13 German public order). German literature has interpreted this holding as supporting German courts'
 14 receptivity to submission of evidence obtained pursuant to Section 1782. See, e.g., Schonknecht,
 15 Beweisbeschaffung in den USA zur Verwendung in deutschen Verfahren, GRURInt 2011, 1000,
 16 1007 with reference to Eschenfelder, Verwertbarkeit von Discovery-Ergebnissen in deutschen
 17 Zivilverfahren, RIW 2006, 443, 447; see also Müller-Stoy, Grundzüge des U.S.-amerikanischen
 18 Patentverletzungsverfahrens, GRUR Int. 2005, 558, 563.

19 20. Furthermore, there is no law, rule of evidence, or rule of procedure in German civil
 20 proceedings that prohibits a party from seeking discovery pursuant to Section 1782, and then using
 21 any evidence obtained through a Section 1782 application in German court proceedings. Rather, the
 22 presentation of documents is generally admissible evidence in Germany, see Section 415 Code of
 23 Civil Procedure; "Urkundenbeweis," and HP is entitled to submit evidence in support of its position
 24 in German proceedings, regardless of whether the evidence has been obtained pursuant to Section
 25 1782.

26 21. Indeed, I have personally submitted information and documents, including license
 27 agreements like those requested by HP here, that were obtained pursuant to discovery proceedings
 28 under 28 U.S.C. § 1782 in several German proceedings. In none of those cases did the court ever

1 doubt whether such evidence was admissible. In all cases, the court simply proceeded to take the
2 evidence into consideration.

3 22. As the German Court would accept the formal introduction of the documents that HP
4 requests here, a US court's order requiring the production of these documents would not offend the
5 German Court or violate any order of such Court.

6 I declare under penalty of perjury under the laws of the United States of America that the
7 foregoing is true and correct.

8 Executed this 15 day of May 2024, at Düsseldorf, Germany.

9 /s/ 

10 Stephan Dorn
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